

REMARKS

Claims 1, 2, 4, 5, 8, 9, 11, 12 and 13 have been amended.

Upon entry of the Amendment, claims 1-13 are all the claims pending in the application.

Applicants have amended the specification. On page 9, lines 14-16, Applicants have added the word “or” after the term group. On page 11, lines 20-25, page 13, lines 23-29 and page 14, lines 1-21, Applicants have deleted “1-[(4-chlorophenyl)phenylmethyl]piperazine” to recite “4-(tert-butoxycarbonyl)piperazine compound.” Support for this amendment can be found on page 14, lines 23-27. On page 15, line 11 to page 16, line 1, Applicants have amended “1-[(4-chlorophenyl)phenylmethyl]piperazine” to recite “4-(tert-butoxycarbonyl)piperazine compound,” and amended “formula (1)” to “formula (1’).” Support for this amendment can be found on page 14, lines 23-27. On page 16, lines 2-23, Applicants have amended “formula (1)” to “formula (1’).” On page 17, lines 4-11, Applicants have added the word “by” after the word “produced.”

The Examiner objects to the Abstract. It is asserted that a colon should appear instead of a period after “formula (1).”

Applicants have amended the abstract as suggested by the Examiner. Applicants respectfully request the Examiner reconsider and withdraw the objection of the abstract.

Claims 1, 2, 4, 8-12 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

It is asserted that there is an extraneous mark in claims 1, 2, and 4. It is asserted that a period is missing at the end of claim 8. It is asserted that in claim 9, reacting a racemic mixture

of reactant (1'') with an optically active acid is inconsistent with producing an optically active adduct salt. It is asserted that in claim 12, the product of formula (6) must be optically active, and not racemic.

Applicants have deleted the "extraneous" mark from claims 1, 2, and 4. Applicants have amended claim 8 to conclude with a period. Applicants have amended claim 9 to recite "* are as defined above, and an enantiomer thereof, with an optically active acid formula (2) as defined above and isolating the resulting adduct salt." Applicants have amended claim 11 to recite "wherein X denotes a chlorine atom, a C1-C3 alkyl group or a C1 to C3 alkoxyl group and * designates an asymmetric carbon atom." Support for this amendment can be found on page 6; lines 9-10. Applicants have amended claim 12 to recite "optically active" in the preamble, and "* are as defined." Applicants have also amended claim 12 to correct typographical errors appearing in the previous claim amendment.

Additionally, Applicants submit that claim 9 is directed to a process for obtaining the acid adduct salt of formula (3) from a racemate or a composition containing the optical isomer of formula (1') and an enantiomer in an optional ratio. The process is directed to optical resolution of the racemate or a mixture of an optical isomer and an enantiomer thereof. The descriptions from line 13, page 11 to line 4, page 12 explain the process. Applicants submit that it would have been apparent to those skilled in the art from the present specification that once such optical resolution is conducted from racemate, then a mixture of a desired optical isomer and an enantiomer thereof can be obtained and that such a mixture can also be subjected to the optical resolution method as claimed.

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Applicants submit that the claims are clear and definite. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the § 112 rejection, second paragraph, rejection.

Claims 1-13 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement.

Applicants submit that [(4-chlorophenyl)phenylmethyl]piperazine is a known compound and the production method thereof is disclosed in GB 2225321, which is cited in the specification and published on May 30, 1990. [(4-chlorophenyl)phenylmethyl]piperazine was commercially available prior to the filing date of the present application or the priority date (see the copy of page 322 of the Aldrich Catalogue).

JP61-35189B discloses 4-chlorophenylphenylmethyl chloride was commercially available before the filing date of the present application (see Applicants' handwritten note at col. 16 to 20, which illustrates the synthetic procedures described therein). Further, in Example 3, JP61-35189B discloses the production of [(4-chlorophenyl)phenylmethyl]piperazine.

GB2076403, a UK counterpart of JP61-35189E discloses the starting compound on page 9. JP4-154736A discloses the same compound, pages 10 and 11.

The representative starting compounds that are embraced by formula (4) are commercially available or the material for producing the compound of formula (1) can be obtained according to the disclosure. As such, Applicants submit that the specification as of the filing date is enabling.

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In *In re Hawkins*, the claimed invention related to a process using a novel compound to produce caprolactam, which novel compound was the subject matter of a co-pending earlier filed U.S. application. 179 U.S.P.Q. 157 (C.C.P.A. 1973). The court held that the mere cross-reference to co-pending GB applications did not appear to be helpful for a person ordinary skill in the art to carry out the invention. However, in the present application, the cited Japanese patent documents are available before the priority date of the present application as seen from their publication dates. The attached copy of the Aldrich catalogue from 1996-1997 demonstrates the starting materials were accessible to the public.

In view of the disclosures of the cited documents, the availability of the information contained therein, and the starting compounds *per se*, Applicants submit that the present specification provides a fully enabling disclosure for the invention, as claimed, and that the disclosure would enable one of ordinary skill in the art to make and use the invention, as claimed, without undue experimentation. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the §112, first paragraph, rejection.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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CUSTOMER NUMBER

Date: April 12, 2004



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